

### **REMARKS**

This is a full and timely response to the Office Action of January 19, 2007.

Reconsideration and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this Response, claims 1-9, 11-15, 17-19, and 33-42 are pending in this application. Claims 1 and 11-13 have been amended. Claims 27-28 have been withdrawn by the Examiner. Claims 33-42 are newly added. Claims 10, 16, 20-26, and 29-32 are canceled. The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims. Applicants believe that no new matter has been added by the amendments and that a new search is not necessary.

### **CLAIMS**

Claim 1 is rejected under 35 U.S.C. §103(a) as purportedly being obvious by Janney et al. (U.S. Patent 6,228,299) in view of the web site noted in the Office Action.

Applicants traverse each of the §103 rejections in the Office Action and submit that the rejection of claim 1 under 35 U.S.C. §103 in view of cited references should be withdrawn because the cited references, individually or in combination, do not disclose, teach, or suggest each and every feature of claim 1 above.

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the cited art reference must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., *In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, "[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the cited art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

In order to establish the *prima facie* case of obviousness, the Examiner must establish a suggestion or motivation either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine reference teachings in order to result in the claimed invention. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest **both** the combination of elements **and** the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of these two prior art references, the prior art must properly suggest the desirability in the references themselves for combining the particular elements.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The Office has stated that since "the genus of such additives is small, it would have been obvious to one of skill in the art ...to include any of the disclosed additives, including a

plurality of fibers for property improvement and thereby obtain the instant invention." The Office has not satisfied its prima facie case and Applicants request that the next non-final Office Action state where in the reference(s) there is a teaching or suggestion to modify the reference, in particular, the desirability to modify the reference, and that there is a reasonable expectation of success, both of which are found in the prior art, and not based on the Applicant's disclosure.

Janney does not teach, disclose, or suggest that "the fibers are selected from polymer fibers, ceramic fibers, carbon fibers, glass fibers, and combinations thereof" as recited in claim 1. Janney merely provides a laundry list of additives. One skilled in the art would not conclude that the fibers are those fibers featured in claim 1. Janney provides no discussion or guidance that would lead one skilled in the art to conclude that the additives could include the fibers featured in claim 1. The Office Action asserts that the genus of such additives is small, but provides no basis for such a conclusion. It appears that the additives provided in the laundry list are extensive (e.g., electrolytes, fungicides, etc). In addition, Janney provides no guidance for selection of the additives. One skilled in the art would have no way knowing what additives to use, the amount of the additives, and the like. More specifically, Janney provides no guidance regarding the type of fiber, the amount of fiber, and the like. In addition, one skilled in the art would not have a reasonable expectation of success without undue experimentation since no guidance is provided in Janney. Even if the genus were small, which Applicants submit is not accurate, what bearing does such a conclusion have on the instant case. It appears the Office Action is stating since the genus is small that this enables one skilled in the art to know to add certain additives to the composition. However, the Office still has not satisfied its prima facie case by stating where in the reference(s) there is a teaching or suggestion to modify the reference, and that there is a reasonable expectation of success. One skilled in the art would not know that the laundry list of additives includes the fibers featured in claim 1, and would not have a reasonable expectation of success since Janney has not provided any

guidance whatsoever regarding what additives to use, the amounts of additives, and the like. Thus, for at least this reason the rejection of claim 1 should be withdrawn.

#### **Claims 2-9, 11-15, 17-19, and 33-42**

Applicants traverse all of the 103 rejections in the Office Action. Applicants respectfully submit that pending dependent claims 2-9, 11-15, 17-19, and 33-42 include every feature of independent claim 1 and that the cited references fail to teach, disclose, or suggest at least the features of claim 1. Thus, pending dependent claims 2-9, 11-15, 17-19, and 33-42 are also allowable over the prior art of record. In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Notwithstanding the previous reasons for allowance, the cited references do not teach “the acidic component is selected from alginic acid, gum arabic, nucleic acids, pectins, proteins, carboxymethylcellulose, ligninsulphonic acids, acid-modified starch, polyvinyl sulphonic acid, polystyrene sulphonic acid, polysulphuric acid, polyvinyl phosphonic acid, polyvinyl phosphoric acid, the homo- and copolymers of unsaturated aliphatic carbonic acids, the anhydrides of the unsaturated aliphatic carbonic acids, and combinations thereof” as recited in claim 33. Therefore, claim 33 is in condition for allowance.

Notwithstanding the previous reasons for allowance, the cited references do not teach “the viscosity modifier is selected from ethanol, hexanediol, pentanediol, potassium aluminum sulphate, isopropanol, diethylene monobutyl ether, dodecyltrimethylammonium propoane sulphonate, ethyl acetoacetate, polyvinyl pyrrolidone, sodium polyacrylate, and combinations thereof” as recited in claim 34. Therefore, claim 34 is in condition for allowance.

Notwithstanding the previous reasons for allowance, the cited references do not teach “the surface tension modifier is selected from ethanol, hexanediol, pentanediol, tergitols, fluorosurfactants, and combinations thereof” as recited in claim 35. Therefore, claim 35 is in condition for allowance.

Notwithstanding the previous reasons for allowance, the cited references do not teach "the basic component is a reactive glass; wherein the acidic component is a polyacrylic acid; wherein the acrylate is a difunctional acrylate; wherein the oxidizing agent is peroxide; wherein the reducing agent water-soluble amine; wherein the binder is water; wherein the viscosity modifier is ethanol; and wherein the surface tension modifier is a fluoro surfactant" as recited in claim 36. Therefore, claim 36 is in condition for allowance.

Notwithstanding the previous reasons for allowance, the cited references do not teach "the composition comprises two of the following: wherein the basic component is a reactive glass; wherein the acidic component is a polyacrylic acid; wherein the acrylate is a difunctional acrylate; wherein the oxidizing agent is peroxide; wherein the reducing agent water-soluble amine; wherein the binder is water; wherein the viscosity modifier is ethanol; and wherein the surface tension modifier is a fluoro surfactant" as recited in claim 37. Therefore, claim 37 is in condition for allowance.

Notwithstanding the previous reasons for allowance, the cited references do not teach "the composition comprises three of the following: wherein the basic component is a reactive glass; wherein the acidic component is a polyacrylic acid; wherein the acrylate is a difunctional acrylate; wherein the oxidizing agent is peroxide; wherein the reducing agent water-soluble amine; wherein the binder is water; wherein the viscosity modifier is ethanol; and wherein the surface tension modifier is a fluoro surfactant" as recited in claim 38. Therefore, claim 38 is in condition for allowance.

Notwithstanding the previous reasons for allowance, the cited references do not teach "the composition comprises four of the following: wherein the basic component is a reactive glass; wherein the acidic component is a polyacrylic acid; wherein the acrylate is a difunctional acrylate; wherein the oxidizing agent is peroxide; wherein the reducing agent water-soluble amine; wherein the binder is water; wherein the viscosity modifier is ethanol; and wherein the surface tension modifier is a fluoro surfactant" as recited in claim 39. Therefore, claim 39 is in condition for allowance.

Notwithstanding the previous reasons for allowance, the cited references do not teach "the composition comprises five of the following: wherein the basic component is a reactive glass; wherein the acidic component is a polyacrylic acid; wherein the acrylate is a difunctional acrylate; wherein the oxidizing agent is peroxide; wherein the reducing agent water-soluble amine; wherein the binder is water; wherein the viscosity modifier is ethanol; and wherein the surface tension modifier is a fluoro surfactant" as recited in claim 40. Therefore, claim 40 is in condition for allowance.

Notwithstanding the previous reasons for allowance, the cited references do not teach "the composition comprises six of the following: wherein the basic component is a reactive glass; wherein the acidic component is a polyacrylic acid; wherein the acrylate is a difunctional acrylate; wherein the oxidizing agent is peroxide; wherein the reducing agent water-soluble amine; wherein the binder is water; wherein the viscosity modifier is ethanol; and wherein the surface tension modifier is a fluoro surfactant" as recited in claim 41. Therefore, claim 41 is in condition for allowance.

Notwithstanding the previous reasons for allowance, the cited references do not teach "the composition comprises seven of the following: wherein the basic component is a reactive glass; wherein the acidic component is a polyacrylic acid; wherein the acrylate is a difunctional acrylate; wherein the oxidizing agent is peroxide; wherein the reducing agent water-soluble amine; wherein the binder is water; wherein the viscosity modifier is ethanol; and wherein the surface tension modifier is a fluoro surfactant" as recited in claim 42. Therefore, claim 42 is in condition for allowance.

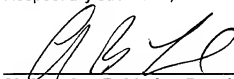
### **CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

In addition, any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. B. Linder', is written over a horizontal line.

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**CERTIFICATE OF MAILING**

I hereby certify that the below listed items are being deposited with the U.S. Postal Service as first class mail in an envelope addressed to:

**Mail Stop Amendment  
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P.O. Box 1450  
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on 4/12/07

Sara Rogers  
Sara A. Rogers

In Re Application of:

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Confirmation No.: 2217

Group Art Unit: 1713

Examiner: Satya B. Sastri

Docket No. HP: 200313424-1  
TKHR: 050834-1370

The following is a list of documents enclosed:

Return Postcard  
Amendment  
Amendment Transmittal Sheet